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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/497,552	02/03/2000	Guido Maurizio Oliva	3572-15	7648

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NIXON & VANDERHYE, PC
1100 N GLEBE ROAD
8TH FLOOR
ARLINGTON, VA 22201-4714

EXAMINER	
LESTER, EVELYN A	
ART UNIT	**PAPER NUMBER**
2873	

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/497,552	OLIVA, GUIDO MAURIZIO	
	Examiner	Art Unit	
	Evelyn A. Lester	2873	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 March 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2 and 4-37* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *17-21,23-25,27 and 28* is/are allowed.

6)☒ Claim(s) *1,2,4,5,11-15,26,29 and 32-37* is/are rejected.

7)☒ Claim(s) *6-10,16,22,[redacted],30 and 31* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *3-15-04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The claim rejections under 35 U.S.C. 112, second paragraph, of claims 1, 2, 4-25 and 27-36, are hereby withdrawn in light of the Applicant's amendments to these claims, filed on 3-15-04.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 32-35 and 37 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Nomura et al (U.S. patent 6,342,976 B1).

Nomura et al discloses the claimed invention of an optical device for focusing a laser beam, wherein the optical device comprises a single optical element upon which the laser beam is directed, and the single optical element comprises a focusing lens (5) in a central portion (11) of the optical element and a first means (12) of a diaphragm or reflective material (i.e. opaque) in a surrounding portion of the optical element and around an outer edge of the focusing lens, which is adapted to separate a central portion of the laser beam from a surrounding portion of the laser beam and wherein the

entire central portion of the laser beam collected by the lens is focused. Please note Nomura et al at Figures 2, 3A and 4, and their accompanying text; as well as at column 2, lines 29-38 and column 6, lines 3-37.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c)may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1, 2, 4, 5, 11-15, 26, 29 and 32-36 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 6-14 and 17 of copending Application No. 09/773,384 (which is also published application number US 2002/0050517 A1, filed on February 1, 2001). Although the conflicting claims are not identical, they are not patentably distinct from each other because each claimed invention of the applications is merely a variation of the other, wherein one invention would anticipate the other.

Each claimed invention recites an optical device, wherein a laser light beam is focused by a focusing lens and a first means or a diaphragm, directly on the focusing lens (claim 1 of the instant invention and claim 13 of the other application's claimed invention) which selects only a central portion of the laser beam, and further wherein the first means or diaphragm defines an aperture having a Fresnel number less than 2. The copending application's claimed invention further describes a source of a laser light beam. However, this is inherent to the present claimed invention, which claims a laser beam. One of ordinary skill in the art would know to provide a source of laser light to provide the appropriate laser beam for the claimed optical device.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Allowable Subject Matter

4. Claims 6-10, 16, 22, 30 and 31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

5. Claims 17-21, 23-25, 27 and 28 are allowed.

6. The following is a statement of reasons for the indication of allowable subject matter:

The prior art does not show or fairly suggest the claimed subject matter and the claimed invention of an optical device having the claimed structure and claimed limitations, wherein a rejection under 35 USC 102 or 103 would be improper. Please particularly note the combination of claimed elements and claimed limitations, including as recited in claim 17, the focusing lens having a substantially tubular portion of lens which extends from the front surface of the focusing lens and is adapted to be mounted by interference on a support structure for the source of emission and the tubular portion having an inner wall provided with at least one tooth extended in a substantially radial direction and adapted to be housed into a corresponding housing obtained on the support structure of the source of emission; as recited in claim 21, wherein the means for allowing the optical alignment between the source of emission and the focusing lens has at least two strips which extend from the front surface of the lens and are adapted to be mounted by interference on a support structure of the source of emission; as

recited in claim 23, the optical alignment means having a tubular container housing wherein the focusing lens has a reference notch intended for being positioned in alignment with the visual reference marked on the container; as recited in claim 25, wherein the container has an internal guide adapted to cooperate with an alignment slot formed on the focusing lens; and as recited in claims 27-28, wherein the first means is directly and integrally applied on the focusing lens and defines on the focusing lens an aperture having a Fresnel number which is smaller than 2 along the fixed reading direction.

With respect to claims 6-10, 16, 22, 30 and 31, please note the reasons for indicating allowable subject matter given in paper 18, mailed on 9-16-03.

Response to Arguments

7. Applicant's arguments filed 3-15-04 have been fully considered but they are not persuasive.

With respect to the Applicant's arguments directed toward the prior art rejection of claims 32-35 and new claim 37 are not well received.

The Applicant points out that claim 32 recites the first means forms part of the optical element, but does not form part of the focusing lens and that the focusing lens is disposed in a central portion of the single optical element, so that the entire central portion of the laser beam collected by the focusing lens (e.g. all the portion of the laser beam incident on the focusing lens) is focused.

First of all, the limitation that "all the portion of the laser beam incident on the focusing lens" is not claimed. The claimed invention recites that "the entire central

portion of the laser beam collected by the lens is focused." So only that portion which is central is focused.

Further, it is apparent that the Applicant has failed to recognize that Nomura et al's invention is interpreted to read on the claimed invention as written, or in other words, that the scope of the claimed invention allows for an interpretation wherein Nomura et al's invention meets the claimed invention. Nomura et al's invention has a lens "base," which is the optical element, wherein the focusing lens is portion 11 and the first means is portion 12. The scope of the claimed invention, in light of the specification, does not preclude other interpretations. As noted for example on page 17, line 31 to page 18, line 4, the Applicant's describe the single optical element as:

> "...the focusing lens and the means adapted to introduce diffraction constitute a single optical element comprising in a central portion the focusing lens and in a surrounding portion, a surface of opaque material adapted to obstruct the propagation of the surrounding portion of the beam."

Therefore, the claimed invention is met by the interpretation of Nomura et al's invention.

Further, with respect to the first means being a separate element which is applied on and around an outer edge of the lens to result in one composite optical element, Nomura et al's invention meets this limitation. Nomura et al deposit a separate material on the surrounding portion of the focusing lens, which makes this a separate element from the focusing lens. Once the material is deposited and formed accordingly, the focusing lens and the surrounding portion result in a composite optical element.

Also, with respect to the Applicant's arguments that Nomura et al's invention only allows part of the beam to pass and diffracts the other part (e.g. not focused) is not well received. Claim 32 recites that the "entire central portion of the laser beam collected by the lens is focused." In Nomura et al's invention, the entire central portion is focused, wherein the surrounding portion of the laser beam is separated from the central portion, as the claimed invention requires.

It is also noted that Nomura et al utilizing their optical device as a DVD/CD reader is of no consequence. Claim 32 is simply an optical device.

Therefore, Nomura et al's invention is interpreted as meeting all the claimed limitations of an optical device for focusing a laser beam, as recited in claims 32-35 and 37.

Regarding the provisional obviousness-type double patenting rejection, this rejection is proper and hereby maintained. The application is not in condition for allowance, except for the obviousness-type double patenting rejection.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evelyn A. Lester whose telephone number is (571) 272-2332. The examiner can normally be reached on M- F, from about 10 am to 7 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached on (571) 272-2328. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Evelyn A. Lester
Primary Examiner
Art Unit 2873